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Attorney Docket: 20269/1201776-us1

MAY 29 2008

U.S. PATENT NO. 6,602,911

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent No.: 6,602,911

) Group Art Unit: 1614

Issued: August 5, 2003

) Examiner: Rebecca Cook

For: METHODS OF TREATING
FIBROMYALGIA, CHRONIC
FATIGUE SYNDROME AND PAINMail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED FOR FAILURE TO NOTIFY THE OFFICE OF A FOREIGN OR
INTERNATIONAL FILING UNDER 37 C.F.R. § 1.137(f)**

The application that issued as U.S. Patent No. 6,602,911 ("the '911 patent), Serial No. 10/028,547, may have become abandoned while pending, pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application under a multinational international treaty that requires publication of applications eighteen months after filing. Patentees do not believe the application went abandoned, and the Patent Office did not notify Applicants that the application had been abandoned. However, in an abundance of caution, they are filing this petition pursuant to 37 C.F.R. 1.137(f) and requesting retroactive revival of this application under 37 C.F.R. 1.137(b).

As described in the attached statement, Applicants efforts reflected a deliberate course of action to maintain the pendency of the instant application and therefore are inconsistent with a deliberate decision not to file a Notice of Foreign Filing in this application or a deliberate

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decision to delay filing this Petition to Revive. Patentees hereby petition for retroactive revival of this application if it is determined that it became abandoned at any point, since any delay was unintentional. The Commissioner is authorized to charge the petition fee of \$1,540.00 as set forth in 37 C.F.R. § 1.17(m) to our Deposit Account No. 04-0100.

If there are any other fees due in connection with the filing of this response, including any fees required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested, and the Commissioner is authorized to charge any related fees to our Deposit Account No. 04-0100.

A Power of Attorney to Darby & Darby P.C. and a Statement Under 37 CFR 3.73(b) is being filed herewith.

Dated: May 29, 2008

Respectfully submitted,

By 

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For: METHODS OF TREATING
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FATIGUE SYNDROME AND PAIN**Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

**STATEMENT IN SUPPORT OF PETITION FOR REVIVAL OF AN APPLICATION FOR
PATENT ABANDONED FOR FAILURE TO NOTIFY THE OFFICE OF A FOREIGN OR
INTERNATIONAL FILING UNDER 37 C.F.R. § 1.137(f)**

In Fall of 2007, in preparation of a product launch, the file history of U.S. Patent No. 6,602,911 ("the '911 patent") and its parent, U.S. Patent No. 6,635,675 ("the '675 patent"), were reviewed by the licensee of the '911 patent, Forest Laboratories, Inc. ("Forest"). During the review, Forest was the first to learn of the possibility that the application that issued as the '911 patent, Serial No. 10/028,547, may have become abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application under a multinational international treaty that requires publication of applications eighteen months after filing. Forest subsequently informed the Patentees of the possible abandonment.

On behalf of Forest, the undersigned subsequently investigated the facts surrounding the possibility that the instant application may have become abandoned. The following statement is a detailed explanation of those facts as understood by the

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undersigned based on a review of the prosecution file history, supporting documentation in the files of the attorney of record during the relevant time frame, Gary J. Speier, and an interview with Mr. Speier. The statement is supported by a declaration provided by Mr. Speier

I. Summary

After filing the above-identified application and a Non-publication Request under 37 C.F.R. 1.213, an application was filed under the Patent Cooperation Treaty, which requires publication of applications eighteen months after filing. The subsequently filed international application claimed priority to the instant application and was filed on December 19, 2002. On February 3, 2003, a Request to Rescind Previous Nonpublication Request under 35 U.S.C. 122(b)(2)(B)(ii) was filed in the United States Patent and Trademark Office. The request was filed within 45 days of the December 19, 2002, filing date of the international application as required under 35 U.S.C. 122(b). However, a previous international application disclosing the same invention but not claiming priority to the instant application had been filed on November 5, 2002. While Forest and the Applicants believe the Request to Rescind Previous Nonpublication Request was timely filed, if a Request should have been filed under 35 U.S.C. 122(b) in the instant application 45 days from the November 5, 2002 filing date, then the Request filed in the instant application was delinquent and the instant application went abandoned on December 21, 2002.

Any delay in filing the required notice of a foreign or international filing from the due date until the actual filing of the Request to Rescind Previous Nonpublication

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Request on February 3, 2003 and to the filing of a grantable petition under 37 C.F.R. 1.137(b) was unintentional. Applicants have worked diligently to explain and correct the possible abandonment from the time they learned of the possible unintentional abandonment to the filing of this Petition. Applicants present the following facts in support of this statement.

II. Facts

Applicants filed the application that issued as the above-mentioned patent on December 19, 2001 through previous counsel of record, Cooley Godward, L.L.P. ("Cooley"). This application, U.S. Patent Application No. 10/028,547 ("the instant application") is a Continuation-in-Part ("CIP") of U.S. Patent Application No. 10/014,149 ("the '149 application"), filed in the U.S. Patent and Trademark Office on November 5, 2001. Concurrent with the filing of each application, Applicants filed a non-publication request.

On June 4, 2002, Schwegman, Lundberg, Woessner & Kluth, P.A. ("Schwegman") replaced Cooley as counsel of record for both applications. *Declaration of G. Speier*, ¶ 3. On November 5, 2002, Schwegman filed an application under the Patent Cooperation Treaty ("PCT") corresponding to and claiming benefit of the '149 application. *Id.* This PCT application did not claim the benefit of the instant (CIP) application. On December 19, 2002, a PCT application was filed based on the instant application, claiming priority only to the instant application, but not to the '149 application. *Id.*

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New counsel at Schwegman, Gary J. Speier, was originally unaware that non-publication requests had been filed in both the instant application and the '149 application. *Id.* at ¶ 4. Upon learning this, Mr. Speier realized that the statutory period for giving notice to the Office of the filing of the corresponding PCT application had lapsed on December 20, 2002, 45 days after the PCT filing date of November 5, 2002. *Id.* Mr. Speier immediately, on February 3, 2003, filed a Petition to Rescind Non-publication Request and a Petition to Revive the '149 application under 37 C.F.R. 1.137(b). *Id.* The Office granted the Petition to Revive on February 21, 2003.

Based on the filing date of the PCT application claiming benefit to the instant application, Mr. Speier determined that notice to the Office of the PCT filing was due by February 3, 2003, 45 days after the PCT filing date of December 19, 2002. *Id.* at ¶ 5. A Petition to Rescind Non-publication Request was believed to be timely filed with the Office on February 3, 2003. *Id.*

After February 3, 2003, power of attorney was changed from Schwegman to Holland & Knight, L.L.P. for both applications. On August 5, 2003, the instant application issued as U.S. Patent No. 6,602,911 ("the '911 patent"). On October 21, 2003, the '149 application issued as U.S. Patent No. 6,635,675 ("the '675 patent").

In Fall of 2007, the file history of the '911 patent and its parent, the '675 patent, were reviewed by the licensee of the '911 patent, Forest Laboratories, Inc. ("Forest"). Forest was the first to learn, and subsequently informed Patentees, of the possibility that the Request to Rescind Non-publication Request filed in the instant application may have not been timely filed because the due date for the notice may have been

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incorrectly determined. As a result, the instant application may have become abandoned.

Specifically, Mr. Speier determined that the due date for filing a Petition to Rescind Non-publication Request for the instant application was February 3, 2003, i.e. 45 days after the December 19, 2002 filing date of the corresponding PCT application. *Id.* at ¶ 5. Because a Petition to Rescind Non-publication Request was filed by that due date the attorneys believed that notice to the Office of the PCT filing was no longer required and the instant application would continue pendency after February 3, 2003. *Id.* at ¶ 6.

But, as Forest recently realized, the instant application is substantially similar to the '149 application and could potentially have a December 20, 2002 due date for notice to the Office of the filing of an international application, i.e. 45 days after the November 5, 2002 filing date of the *PCT application based on the parent '149 application*.

In relevant part, the statute states that:

An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application *directed to the invention disclosed* in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

35 U.S.C. § 122(b)(2)(B)(iii) (emphasis added).

Mr. Speier reasonably interpreted the statute as requiring notice to the Office 45 days after the filing of the PCT application corresponding to the instant application. *Id.*

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But, because, as a CIP application, the instant application has substantially the same disclosure as the parent '149 application, the PCT application based on the '149 application could be interpreted as "*directed to the invention disclosed*" in the instant application. In that case, the statute could be interpreted to require notice to the Office in the instant application 45 days after the filing of the PCT application based on the '149 application, December 20, 2002, not 45 days after PCT filing based on the *instant application*, February 3, 2003.

Importantly, patent practitioners at the time were having difficulty interpreting the aforementioned statute. As a result, the Office released an OG Notice in May of 2003, several months after Schwegman filed their rescission of a nonpublication request to provide guidance. In view of even greater number of inquiries after the May notice, the Office released another OG Notice in July 2003 to provide further clarification of the statute. The superseding July 2003 OG Notice was provided almost five months after Schwegman filed the rescission request. Even today with the clarification, Forest and the Applicants are unsure of the correct interpretation and therefore, in an abundance of caution, are requesting a Petition to Revive.

The resulting determination of the due date for notice to the Office of the PCT filing (and/or filing of a Petition to Rescind Non-publication Request) was reasonable based on the fact that the attorneys involved were not and still are not aware of the official USPTO interpretation of the statute. Therefore, any delay, if present, in filing the Request to Rescind Non-publication Request was unintentional.

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Moreover, the entire delay in the filing of a grantable petition under 37 C.F.R. 1.137(b) was unintentional as Applicants only became aware of the possible abandonment during a recent review of the file history of the issued patent.

Each petition to revive an abandoned application is considered on a case-by-case basis. See *In re Application G*, 1989 Commr. Pat. LEXIS 4 (April 20, 1989). "The relevant inquiry in determining whether a delay is intentional is whether the course of action resulting in the delay was . . . deliberate." *In re Application of Wodarz et al.*, 2006 Commr. Pat. LEXIS 24 at *11 (Oct. 27, 2006); See also M.P.E.P. § 711.03(c)(II)(C)(1) ("A delay resulting from a deliberately chosen course of action on the part of the applicant is not an 'unintentional' delay within the meaning of 37 CFR 1.137(b)").

It is well settled that a deliberate decision (either action or inaction), as opposed to an accident or oversight, that results in delay does not qualify as an unintentional delay within the meaning of 37 C.F.R. 1.137(b), regardless of whether the Applicant intended to abandon the application. See e.g. *Field Hybrids, LLC v. Toyota Motor Corp.*, Civil No. 04121 ADM/JSM, 2005 U.S. Dist. LEXIS 1159 at *22 (D. Minn. Jan. 27, 2005) (finding delay was not unintentional based on decision of Applicant not to file a response to an outstanding office action); *Lawman Armor Corp. v. Simon*, No. 04-CV-72260, 2005 U.S. Dist. LEXIS 10843 at *15-16 (E.D. Mich. Mar. 29, 2005) (same); *In re Application G*, 1989 Commr. Pat. LEXIS 4 at *9 (Feb. 2, 1989) (same); *In re Application of Wodarz et al.*, 2006 Commr. Pat. LEXIS 24 at *12 (Oct. 27, 2006) (same); *In re Application of Mark V. Dahl*, 2006 Commr. Pat. LEXIS 21 at *12 (May 16, 2006) (same); *In re Application of Pierre E. Maldague*, 1998 Commr. Pat. LEXIS 22 at *3 (June 10, 1988) (same). This is true for a delay that results in an application becoming

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abandoned (e.g. decision not to pursue further prosecution) as well as any delay in seeking the revival of an abandoned application. See M.P.E.P. § 711.03(c)(II)(D).

Here, at no time did Applicants, through the attorneys involved in the prosecution of the instant application, make a deliberate choice to delay filing a notice of foreign filing. This is evidenced by the fact that Applicants are still unsure if the notice filed on February 3, 2003 was delinquent. Moreover, Applicants did not deliberately delay in filing this Petition to Revive after learning of the possibility that the instant application may have become abandoned.

First, Applicants and the attorneys involved took no deliberate course of action (or inaction) that they believed would lead to abandonment of the application. Originally, the attorneys involved were unaware that a Request for Non-publication had been filed in the instant application. When that information was brought to their attention, Applicants promptly dealt with (what they reasonably believed to be) the required Petition to Rescind the Non-publication Request in an effort to maintain the pendency of this application. After that filing, Applicants believed that they had timely satisfied all requirements for notifying the Office of the corresponding PCT application filing. Subsequently, the attorneys of record continued prosecution in the instant application, leading to its issuance as a patent. These actions are inconsistent with a deliberate failure to file a notice of foreign filing with the PTO, leading to abandonment of the instant application.

Second, any delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of Applicants, as supported by the accompanying facts and explanation. Specifically, the attorneys

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Involved followed a reasonable interpretation of the statute when calculating the 45 day window of opportunity to petition the Office to rescind the non-publication request for the instant application. Until the recent review of the file history of the '911 patent revealed the potential abandonment, Applicants had no reason to suspect that the application was abandoned.

Finally, there was no deliberate decision to delay seeking revival of this application after learning of the possibility of abandonment. After learning of the possibility for abandonment, Applicants' attorney has worked diligently to reconstruct the facts and interview attorney Mr. Speier and review Schwegman's files in order to explain and prepare the filing of this Petition.

III. Conclusion

Applicants efforts reflect a deliberate course of action to maintain the pendency of the instant application and therefore are inconsistent with a deliberate decision not to file a Notice of Foreign Filing in this application or a deliberate decision to delay filing this Petition to Revive.

Respectfully submitted,



By: _____

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Reg. No. 45,958

Dated: May 27, 2008